

Amendment Under 37 C.F.R. § 1.111
U.S. Appln No. 09/973,045

Atty Dkt. No. Q64313

Applicant's invention provides systems and methods where information about art objects is provided wirelessly to individual users, so that the users can review this information regardless of the user's location with respect to the art object (e.g., even when a user is moving). In particular, Applicant's claimed invention provides systems and methods for providing an exhibition information service through wireless communication comprising unique combinations of features and method steps including, *inter alia*:

 wireless connection devices for preparing for connection to a wireless terminal in a service region, and outputting information for the wireless terminal through a network, and an exhibition information server processing an information service corresponding to the information inputted through the network (see independent claim 1);

 a wireless connection step for preparing for connection to a wireless terminal in a service region, and outputting information for the wireless terminal through a network, and an exhibition information service step for processing an information service corresponding to the information inputted through the network (see independent claim 9);

 preparing for connection for wireless communication with a wireless terminal in a service region, wireless-connecting to the wireless terminal according to a connection signal, and transmitting an initial screen to provide the service to the wireless terminal (see independent claim 18);

and

 preparing for connection for wireless communication with a wireless connection device in a service region, and receiving an initial

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screen from the wireless connection device in order to read the exhibition information (see independent claim 20).

None of the cited prior art references, applied alone or in any reasonable combination with other references, discloses or suggests such unique combinations of features (claim 1) and method steps (claims 9, 18 and 20).

Sakurai, the Examiner's primary reference, discloses an information communication system where data, such as facsimile communication and electronic mail, are wirelessly distributed from a server to portable radiocommunication terminals.¹ In this regard, Sakurai discloses nothing more than general concepts of distributing information from a server to a wireless terminal. Thus, the Examiner's rejections are based on an inherency theory. In particular, the Examiner alleges that Sakurai's data base server "inherently ... can" store exhibit information (see Office Action, paragraph 2), and therefore, Sakurai suggests the features of an exhibition information server, as recited in Applicant's independent claim 1, and the steps for responding to an exhibition service request, as recited in Applicant's independent claims 9, 18 and 20.

Applicant respectfully submits that the Examiner's "inherency" argument finds no support in the prior art, and is contrary to well established legal principles. *See Tyler*

¹ Applicant notes that the Office Action contains several typographical errors in the citations to Sakurai. In particular: on page 2, line 15 of the Office Action, the cite should be "(abstract, fig. 1-8 col. 4, line 10 thru col. 6 line 65)"; and on page 7, lines 10-11 of the Office Action, the cite should be "(fig 1, col. 11 line 43 through col. 12, line 56, and col. 22, line 51 thru col. 23 line 60)". Applicant replies accordingly.

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Refrigeration v. Kysor Industrial Corp., 777 F.2d 687, 689 (Fed. Cir. 1985) ("A feature is inherent if it naturally occurs under the conditions set forth in the reference, even though the reference does not expressly mention the feature", emphasis added); *see also Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int.) ("In relying upon theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art", original emphasis). Nowhere does Sakurai disclose, teach or suggest that its server stores exhibition information, let alone discloses or suggests any means or process steps for responding to requests of a user for the transmission of exhibition data, as recite in respective claims 1, 9, 18 and 20.

Likewise, the Examiner's position that Sakurai's database server "can" store exhibit information is not persuasive. *See In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic); *see also* MPEP §2112 at 2100-40.

Thus, Applicant's independent claims 1, 9, 18 and 20, as well as the dependent claims 2-8, 11, 14, 15, 17, 19 and 21 (which incorporate all the novel and unobvious features of their respective base claims), are not anticipated by Sakurai at least for these reasons.

On the other hand, Applicant's dependent claim 16, which incorporates all the novel and unobvious features of its base claim 9, would not have been obvious from Sakurai at least for the reasons set forth above with respect to claim 9.

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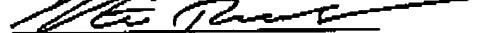
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With regard to Applicant's dependent claims 12 and 13 (which incorporate all the novel and unobvious features of their base claim 9), Albukerk describes a system for providing personal interactive information about art objects where exhibit information is retrieved from object identification devices disposed at the object of interest (see Albukerk, Abstract; and col. 12, lines 16-21). Nowhere does Albukerk disclose, teach or suggest exhibition information service step for processing an information service corresponding to the information inputted through the network, as recited in Applicant's independent claim 9. Therefore, Applicant's dependent claims 12 and 13 would not have been obvious from an unlikely combination of Sakurai and Albukerk at least for this reason, and the reasons set forth above.

Accordingly, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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